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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/447,228	11/22/1999	GENE PHILLIP DIPOTO	0231/0314-00	3547

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EXAMINER

JACKSON, GARY

ART UNIT	PAPER NUMBER
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3731

16

DATE MAILED: 08/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/447,228

Applicant(s)

DIPOTO ET AL.

Examiner

Gary Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19, 21-71, 73-99 and 102-110 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19, 21-71, 73-99 and 102-110 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

*Gary Jackson*

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This action is a response to applicants' amendment filed February 27, 2003.

The rejection of claims 36-46, 48-66, 68-81, 82-88, 94 and 96-101 under 35 USC 102(f) mailed in the Office Action August 27, 2002 has been withdrawn since the rejection was based on a patent from which applicants claimed and was priority.

The indicated allowability of claims 20-23, 32, 47, 82, 89-93 and 95 in the Office Action mailed August 27, 2002 is withdrawn after reconsideration of the Recapture Rule to Reissue Applications. The rejection based on the Recapture Rule is as follow.

#### **Rejection under 35 U.S.C. 251**

Claims 19-99 and 102-110 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

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The claims presented in the parent cases (application serial numbers 08/091,092 and 08/509,966) whether drawn to an anchor per se or the anchor in combination with a driver at included at least three elements. Namely, the claims called for an elongated body having: (1) a suture mount; (2) at least one ridge; and (3) an elongate body having a distal and proximal region configured for engaging a driver. The third element was amended during the prosecution of the to include an element at the proximal end configured for axial positive interengagement with the driver and including one of a protrusion or recess that axially interlock the driver.

The amendments filed April 11, 1996 further limit element (3), and argues this feature in trying to overcome the rejection and gain allowance of the application. After an interview held April 24, 1997, it was agreed to further limit element (3), the amendment filed April 24, 1997 further limit the claims; then the claims were allowed.

The present Reissue application filed November 22, 1999. The application included a plurality of new claims none of which include element (3). The independent claims recite, with varying degrees of specificity or alternative embodiments, element (1) and element (2). Instead of calling element (1) "a suture mount", applicants use "generally transverse, circumferentially bounded opening extending through the body". Instead of calling element (2) a "ridge", applicant use "non-helically extending exterior enlargement".

### **CONCLUSION**

The omitted limitation relates to subject matter previously surrendered by applicants, and accordingly claims 19-110 has been rejected under 35 USC 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which this reissue application is based. Further, the reissue claims are broader in scope than the claims that

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were amended in the original prosecution. Therefore the reissue claims are impermissible under the recapture doctrine.

The examiner has clearly set forth the three step recapture analysis as stated in the *Pannu* court wherein (1) it is shown that the reissue claims are broader than the patent claims; (2) the broader aspect of the reissued claims are related to surrendered subject matter; and (3) and whether the claims were materially narrowed in other aspects. *Pannu v. Storz Instruments Inc.*, 258 F3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001).

### CLAIM FORMAT

*Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.173(b).*

*The amendment filed February 27, 2003 proposes amendments to claims 19, 21, 22, 71, 73, 74 and 77 that do not comply with 37 CFR 1.173(b), which sets forth the manner of making amendments in reissue applications. A supplemental paper correctly amending the reissue application is required. Each new claim (i.e., a claim not found in the patent, that is newly presented in the reissue application) should be presented with underlining throughout the claim.*

### DECLARATION

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

A supplemental oath/declaration under 37 CFR 1.175(b)(1) will be required because the amendments or other corrections of errors in the patent have been made subsequent to the last oath /declaration filed in the application.

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Claims 1-19, 21-71, 73-99 and 102-110 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.


Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Jackson whose telephone number is (703) 308-4302. The examiner can normally be reached on Mon.-Thurs. 7:30 am to 6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on (703) 308-2496. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Gary Jackson  
Primary Examiner  
Art Unit 3731

GJ

February 12, 2004